

REMARKS

The specification at pages 17-18 has been amended.

Claims 6-7, 9-13, 15, 18-35 have been canceled.

Claims 36 and 37 have been added. Claims 36 and 37 do not add new matter.

Claim 1 has been amended to more clearly set forth the claimed subject matter. Claim 2 has been amended to recite "a part thereof" deleting reference to "parts." Neither amended claim 1 or 2 should require the Examiner to conduct a further prior art search.

Claims 7-13 and 21-35 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter not described in the specification. In response to this rejection, Applicant has canceled claims 7, 9-13, and 18-35. Claim 8 is amended to depend from claim 2 or 5. Applicant has canceled claims to hybrid plants, seeds of hybrids plants and to progeny thereof. Applicant has also canceled claims to transgenes. In view of these claim amendments, Applicant respectfully submits that it has overcome the 35 USC 112, first paragraph rejection as set forth on pages 2-8 of the April 30, 2003 Office Action and requests that this rejection be withdrawn.

Claims 1-35 stand rejection under 35 U.S.C. 112, first paragraph as containing subject matter not described in the specification in such a way as to enable one skilled in the art to make and use the claimed invention. The Examiner states that the Applicant has not provided a ATCC deposit number. Applicant has amended the claims and specification to include the ATCC deposit number for seed of the soybean cultivar S52-U3. In view of the amendment to the claims and specification, Applicant respectfully requests that the 35 U.S.C 112, first paragraph rejection set forth on pages 3 and 4 of the Office Action be withdrawn.

Claims 1-35 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failure to particularly point out and distinctly claim the subject matter that the Applicant regards as the invention. Applicant has cancelled claims 6-7, 9-13, 15, 18-35. Applicant has amended the remaining claims to overcome the 35 USC 112, second paragraph rejections. Specifically, Applicant has amended the claims to include the ATCC deposit number corresponding to the soybean cultivar S52-U3. Claim 14 has been amended by deleting the phrase "capable of espressing." Claim 16 is amended to overcome the Examiner's objections as set forth on page 6, 6th and 7th paragraphs and in the first paragraph of the following page. Applicant respectfully

submits that in view of the above amendments and remarks, the Applicant has fully addressed the rejections set forth on pages 5 -10 of the Office Action and requests that these rejections be withdrawn.

Claims 1-35 are rejected under 35 USC 102(b) as anticipated or, in the alternative, under 35 USC 103 as obvious over Rhodes (1999, US Patent 5,294,666).

Claims 1-35 stand rejected under 35 USC 102(b) as anticipated or, in the alternative, under 35 USC 103 as obvious over Luzzi (2000, US Patent 6,084,159).

“When the defense of lack of novelty is based on a printed publication that is asserted to describe the same invention, a finding of anticipation requires that the publication describe all of the elements of the claims...” C.R. Bard, Inc. v. M3 Systems, Inc. 157 F.3d 1340, 48 USPQ2d 1225 (Fed. Cir. 1998) *rehearing denied and suggestion for rehearing in banc declined*, 161 F.3d 1380 (Fed. Cir. 1998). Neither the ‘666 or the ‘159 patent describes or otherwise discloses all of the elements of the subject matter of pending claims 1-5, 8, 14, 16, 17, 36 and 37 and thus both patents must fail as 102(b) art. For example, the soybean cultivar S52-U3 of the invention is resistant to Soybean Cyst Nematodes Races, 3, 9, and 14, whereas soybean cultivar 9392379521283 (1283) of the ‘666 patent is resistant Soybean Cyst Nematodes Races 3 and 14 only. The soybean cultivar 9524889614923 (4923) of the ‘159 patent does not provide resistance to any races of SCN.

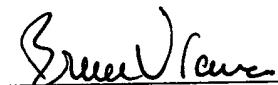
Furthermore, soybean cultivar S52-U3 is an earlier maturity cultivar compared to both soybean cultivars 4923 and 1283. See the table on page 17 of Applicant’s specification and Tables 1 and 2 of the ‘666 patent and Table 1 of the ‘159 patent. Applicant therefore respectfully submits that neither the ‘666 nor ‘159 patent describes all the elements of the pending claims and therefore neither patent is 102(b) prior art. Applicant respectfully requests that the Examiner withdraw the 102(b) rejections based on the ‘666 and ‘159 patents.

The Examiner also states that the claimed invention is obvious in view of the ‘666 patent and alternatively in view of the ‘159 patent. Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness. A *prima facie* case of obviousness is met when: “First, there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success, Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP 706.02(j). Applicant respectfully submits that the prior art references do not

teach or suggest a soybean cultivar that is resistant to Soybean Cyst Nematode resistance races 3, 9, and 14, nor does either of these patents teach or suggest a relatively early cultivar S52-U3 of the present invention. In fact, as both soybean cultivars 4923 and 1283 disclosed in patent '159 and '666, respectively, do not contain these elements of the soybean cultivar S52-U3, one skilled in the art would not be able to successfully breed with these cultivars to make the cultivar of the invention. Therefore, Applicant respectfully submits that the '159 and '666 patents, when taken alone or together, do not make the cultivar S52-U3 of the present invention obvious.

In view of the above amendments and remarks, it is submitted that the application is ready for allowance. If any additional information is needed, the Examiner is invited to call the undersigned attorney at (919) 541-8614.

Respectfully submitted,



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